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| 10/582,592 | 06/09/2006 | Norbert Lobig | 2003P18855WOUS | 2028 |
| 29177 | 7590 | 03/04/2009 | EXAMINER | |
| K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690 | | | NDIAYE, CHEIKH T | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/582,592 | LOBIG ET AL. | |
| | Examiner | Art Unit | |
| | CHEIKH NDIAYE | 2447 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 June 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 11-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 09 June 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>06/09/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. The applicants have cancelled claims 1-10 and added new claims 11-25 in the preliminary amendment on 06/09/2006.

The claims 11-25 are pending.

Claim Objections

2. Claims 17, 20, and 24 are objected to because of the following informalities:

Claim 17 recites the limitation "the network management system" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the network management system" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For examination on the merits, the recited limitation will be read as "a network management system" in view of the specification, page 3, paragraph 0011, line 2.

Claim 24 recites the limitation "the a communication loss" in lines 1- 2. There is insufficient antecedent basis for this limitation in the claim.

For examination on the merits, the recited limitation will be read as "a communication loss" in view of the specification, page 10, paragraph 0035, lines 4-5). Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 11-12 and 14-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-17, and 21 of U.S. Application No. 10/582590. Although the conflicting claims are not identical, they are not patentably distinct from each other because of following reasons:

Claims 11-17 and 21 of Application No. 10/582590 contain(s) every element of claim 11-12 and 14-20 of the instant application and thus anticipate the claim(s) of the instant application. Claims of the instant application therefore are not patentably distinct from the earlier patent claims and as such are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

5. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a 35 patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented

invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleine-Altekamp et al (US Patent No. 6,914,879 B1).

With respect to claim 11, Kleine-Altekamp teaches a method for substitute switching of spatially separated switching systems (Abstract), comprising: providing a pair of switching systems having one-to-one redundancy (Abstract), comprising a first switching system in an active operating state in terms of switching, and a second switching system in a hot-standby operating state in terms of switching (i.e., one of the switching matrices is always available as an active switching matrix, and the other is available as a standby matrix in the event of a failure, col. 1, lines 18-21), the second switching system geographically separated from the first switching system (i.e., it is known to install two like network elements in two separate rooms and connect them with one another, col. 1, lines 37-39). Kleine-Altekamp further teaches establishing communication between a monitoring system and at least one of the paired switching systems (i.e., a controller for detecting a fault condition of the active switching matrix and for switching to the redundant switching matrix, col. 1, lines 62-64). Kleine-

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Altekamp further teaches changing over in terms of switching from the active switching system to the hot-standby switching system in the event of a loss of communication to the switching system in the active operating state, wherein the change over occurs in real time (i.e., a controller for detecting a fault condition of the active switching matrix and for switching to the redundant switching matrix, which is then used as a new active switching matrix, col. 1, lines 62-65).

With respect to claim 12, Kleine-Altekamp teaches each switching system comprising a central controller (i.e., two separate controllers 25, 26 are provided, each of which is spatially associated with, and installed in the same room as, a respective one of the units , col. 3, lines 47-50; and 25 and 26, Fig. 2), the method further comprising exchanging test messages between the monitoring system and the central controllers of the paired switching systems (i.e., Alarms and fault messages are signaled by the interface modules and the active switching matrix to the controller, col. 3, lines 31-33).

With respect to claim 13, Kleine-Altekamp teaches the messages are exchanged periodically (i.e., All alarms and messages are still being stored on the hard disk of the second controller 26, col. 4, lines 42-43).

With respect to claim 14, Kleine-Altekamp teaches the exchange of the test messages between the monitoring system and the switching system in the active operating state is controlled via the switching system by sending a test request to the monitoring system and receiving a positive acknowledgement (i.e., The controller controls the active switching matrix and specifies the paths to be switched by the matrix.

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Alarms and fault messages are signaled by the interface modules and the active switching matrix to the controller, col. 3, lines 29-32).

With respect to claim 15, Kleine-Altekamp teaches the exchange of the test message between the monitoring system and the switching system in the hot-standby operating state is controlled via the switching system by sending a test request to the monitoring system and receiving a negative acknowledgement (i.e., the standby components also work during normal operation. Only their output signals are not selected, but ignored by the active components during normal operation, col. 4, lines 7-10).

With respect to claim 16, Kleine-Altekamp teaches the exchange of the test messages between the monitoring system and the switching system in the hot-standby operating state is controlled via the switching system by sending a test request to the monitoring system and receiving no acknowledgement (i.e., the standby components also work during normal operation. Only their output signals are not selected, but ignored by the active components during normal operation, col. 4, lines 7-10).

With respect to claim 17, Kleine-Altekamp teaches reporting to the network management system by the monitoring system the loss of communication with the switching system in the active operating state (i.e., alarms and messages of the individual components of the crossconnect are stored and can be retrieved by the higher-level management system, col. 3, lines 43-46). Kleine-Altekamp further teaches sending changeover instructions to the monitoring system (i.e., via the central network management system, prioritized traffic that can no longer be switched from the interface

modules of the first unit to those of the second unit due to the explosion can then be rerouted, col. 5, lines 46-50).

With respect to claim 18, Kleine-Altekamp teaches the change over is controlled by the monitoring system by sending a positive acknowledgement to a test request sent by the switching system in hot-standby operating state, and wherein the switching system in the hot-standby operating state is changed to the active operating state by the central controller after receiving the positive acknowledgement (i.e., Alarms and messages of the second unit are still being stored on the hard disk of the second controller 26. To be able to access the second unit again, a new control terminal must be connected to the second controller or the connection to the first controller must be restored. To be able to access the second unit from the new control terminal, if the first controller was the active one, the status of the second will be switched to "active". The second unit can then be controlled via the new control terminal, col. 5, lines 35-44).

With respect to claim 19, Kleine-Altekamp teaches the switching system with the communication loss is changed to the hot-standby operating state and is not automatically switched back to the active operating state following a resolution of the communication loss (i.e., since 1:1 redundancy is provided for the switching matrices, in the event of a hardware failure in the active switching matrix 21, controller 25 will switch to the second, redundant switching matrix 22, which then performs the function of a new, active switching matrix, and will deactivate the hitherto active matrix, col. 3, lines 35-40).

With respect to claim 20, Kleine-Altekamp teaches reporting to the network management system by the monitoring system the loss of communication with the switching system in the active operating state (i.e., alarms and messages of the individual components of the crossconnect are stored and can be retrieved by the higher-level management system, col. 3, lines 43-46). Kleine-Altekamp further teaches sending changeover instructions to the monitoring system (i.e., via the central network management system, prioritized traffic that can no longer be switched from the interface modules of the first unit to those of the second unit due to the explosion can then be rerouted, col. 5, lines 46-50).

With respect to claim 21, Kleine-Altekamp teaches the change over is controlled by the monitoring system by sending a positive acknowledgement to a test request, and wherein the switching system in the hot-standby operating state is changed to the active operating state after receiving the positive acknowledgement (i.e., The controller controls the active switching matrix and specifies the paths to be switched by the matrix. Alarms and fault messages are signaled by the interface modules and the active switching matrix to the controller. The latter also serves to detect error conditions caused, for example, by a hardware failure and to switch to a standby module in the event of a failure, col. 3, lines 29-35).

With respect to claim 22, Kleine-Altekamp teaches the switching system with the communication loss is changed to the hot-standby operating state and is not automatically switched back to the active operating state following a resolution of the communication loss (i.e., since 1:1 redundancy is provided for the switching matrices, in

the event of a hardware failure in the active switching matrix 21, controller 25 will switch to the second, redundant switching matrix 22, which then performs the function of a new, active switching matrix, and will deactivate the hitherto active matrix, col. 3, lines 35-40).

With respect to claim 23, Kleine-Altekamp teaches a first monitor (i.e., 25, Fig. 2) comprising: a first communication link to the active switching system, the active switching system in an active operating state in terms of switching (i.e., 31, Fig. 2), a second communication link to a second switching system that is geographically separated from the first switching system, the second switching system in a hot-standby operating state in terms of switching (i.e., controller 25 will switch to the second, redundant switching matrix 22, col. 3, lines 37-38); a second monitor that is geographically separated from the first monitor (i.e., 26, Fig. 2), the second monitor comprising: a first communication link to the active switching system, the active switching system in an active operating state in terms of switching, a second communication link to a second switching system that is geographically separated from the first switching system, the second switching system in a hot-standby operating state in terms of switching (i.e., 32, fig. 2); and a communication link between the first and second monitors (i.e., controllers 25, 26 are connected with one another, col. 3, lines 53-54), wherein a failure on the first communication link triggers the second switching system to change over to the active operating state, and wherein the change over is in real time (i.e., since 1:1 redundancy is provided for the switching matrices, in the event of a hardware failure in the active switching matrix 21, controller 25 will switch to the

second, redundant switching matrix 22, which then performs the function of a new, active switching matrix, and will deactivate the hitherto active matrix, col. 3, lines 35-40).

With respect to claim 24, Kleine-Altekamp teaches the a communication loss between the first monitor and the active switching system causes a synchronization between the monitoring systems in order to trigger the second switching system to change over to the active operating state (i.e., the crossconnect has a second, redundant clock supply 28 as a standby unit, with each of the clock supplies 27, 28 being spatially associated with a respective one of the units. A clock distributor 29 ensures that both clock supplies are synchronized to the same external reference clock. In the event of a failure of the external reference clock source, the two clock supplies can also operate in a free, unsynchronized mode, col. 3, lines 62-67).

With respect to claim 25, Kleine-Altekamp teaches the active switching system determined by both the first and second monitors is maintained active if a communication fault between the first and second monitors occurs (i.e., The status of the controller remains as it was before the fire (here: "active"). Alarms and messages are still being stored on the hard disk of the first controller. The crossconnect can continue to be controlled via control terminal 30, col. 4, line 67).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHEIKH NDIAYE whose telephone number is (571)270-

3914. The examiner can normally be reached on Monday-Friday, 7:30 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joon Hwang can be reached on 571-272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHEIKH NDIAYE/
Examiner, Art Unit 2447

02/27/09

/Joon H. Hwang/
Supervisory Patent Examiner, Art Unit 2447